UNITED STATES PATENT AND TRADEMARK OFFICE

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-52_ is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) _1-52_ is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on _13 September 2002_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☒ All   b)☐ Some * c)☐ None of:
       1.☒ Certified copies of the priority documents have been received.
       2.☐ Certified copies of the priority documents have been received in Application No. _____.
       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _20021114; 20020201_.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2.   **Claims 1-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

The first step in determining whether a claim recites patent eligible subject matter is to determine whether the claim falls within one of the four statutory categories of invention recited in 35 USC 101: process, machine, manufacture and composition of matter. The latter three categories define "things" or "products", while a "process" consists of a series of steps or acts to be performed. For purposes of 101, the analysis of a process is guided by the machine-or-transformation test. *In re Bilski,* __ F.3d __ (Fed. Cir. 2008)(en banc).

Based on Supreme Court precedent (*Diamond v Diehr,* 450 U.S. 175,184 (1981); *Parker v. Flook,* 437 US 584, 588 n.9 (1978); *Gottschalk v. Benson,* 409 U.S. 63, 70 (1972); *Cochrane v. Deener,* 94 U.S. 780, 787-88 (1876)) and recent precedent from the Federal Circuit from *In re Bilski,* the machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. See Benson, 409 U.S. at 70. Certain considerations are applicable to analysis under either branch. First, as illustrated by Benson, the use of a specific machine or transformation of an article must impose meaningful limits on the

claim's scope to impart patent-eligibility. See Benson, 409 U.S. at 71-72. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. See Flook, 437 U.S. at 590. If neither of these requirements is met by the claim, the method is not a patent eligible process under 35 U.S.C. 101.

Claims 1-13 are drawn to **a method for defining and identifying geographic areas**. All of the recited method steps can be performed by the user themselves, in the mind of the user or between different users through writing by a user, and therefor these method steps are not tied to a particular machine nor do they transform an article. To qualify as a statutory process, the claim should positively recite in the body of the claim, the machine to which it is tied. For example, by identifying the machine that accomplishes the method steps, or positively reciting the article that is being transformed.

Please note that *nominal recitations of a machine in an otherwise ineligible method fail to make the method a statutory process.* See Benson, 409 U.S. at 70 - 72. As Comiskey recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." Comiskey, 499 F.3d at 1380 (citing *In re* Grams, 888 F.2d 835, 839-40 (Fed. Cir. 1989)). Incidental physical limitations, such as data gathering, field of use limitations, storing, collecting, sending, receiving, and other forms of insignificant extra solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of involvement of a machine or transformation

in a method claim do not convert an otherwise ineligible claim into an eligible one. Ex

parte Langemyr (2008) and In re Bilski, (Fed. Cir. 2008).

Therefore, the applicable test to determine whether a claim is drawn to a patent-

eligible process under § 101 is the machine-or-transformation test set forth by the

Supreme Court and clarified herein, and Applicants' claim here appears to fail this test.

No new matter should be added.

3.   Claims 27-39 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter.

4.   Claims 27-39 are not proper medium claims under MPEP 2106.01. The

"computer readable medium" language (i.e. Applicant's "embodied program") of the

preamble, being given the broadest reasonable interpretation, does not appear to

positively recite that the program is "tangibly embodied" on the medium with "executable

instructions" that are stored on such medium that "when executed cause the computer

to perform the steps" recited. If the medium were paper with written instructions that are

executable, that is readable by a machine then the claims may not be statutory. If

however, the applicant were to state, "computer readable medium having executable

instructions stored thereon (or computer program tangibly embodied on a computer

readable medium containing executable instructions), the executable instructions

causing the computer to perform the steps of..." then it is unmistakable that the

instructions are actually stored on the medium and the computer actually executes the

steps recited. Please also note In re Beauregard, 53 F.3d 1583 (Fed. Cir. 1995).

5.   **Claims 40-52 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

6.   In particular, claims 40-52 are directed towards a system, without any structural claim limitations. The claims may be directed to software or modules, which are equated to software which are programmed to perform certain functions, but without embodying the applications on any form of structure, or reciting any actual structure of the system, such as a processor, computers or servers. In particular, Applicant's specification discloses in part, "the described implementation includes software, but systems and methods consistent with the present invention may be implemented as a combination of hardware and software or in hardware alone." (i.e. the system may be implemented as software, per se) that lacks structure. MPEP 2106.01.

Claim Rejections - 35 USC § 112

7.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8.   Claims 40-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim element "means for providing", "means for receiving", "means for determining", "means for outputting", "means for incorporating", and "means for denoting", are means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to clearly link or associate the

disclosed structure, material, or acts to the claimed function such that one of ordinary

skill in the art would recognize what structure, material, or acts perform the claimed

function. It is unclear as to what these means encompass structurally. Applicant's

specification indicates that it may be software, software and hardware, or hardware.

Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or

step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it clearly links or

associates the corresponding structure, material, or acts to the claimed function without

introducing any new matter (35 U.S.C. 132(a)); or

(c) State on the record where the corresponding structure, material, or acts are

set forth in the written description of the specification that perform the claimed function.

For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

Claim Objections

9.   Claim 46 is objected to because of the following informalities: It appears that

Applicant may have intended for claim 46 to depend from claim 44 as opposed to claim

5. Appropriate correction is required.

Claim Rejections - 35 USC § 102

10.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11.   **Claims 1-3, 5-7, 14-16, 18-20, 27-29, 31-33, 40-42 and 44-46 are rejected**

under 35 U.S.C. 102(e) as being anticipated by Cossins et al. (US 6,343,290).

12.   **With respect to claims 1, 14, 27 and 40:**

Cossins et al. teaches a method for defining and identifying geographic areas,

comprising:

providing for a geographic region wherein the geographic region is divided into

subregions that are mutually exclusive, and wherein the subregions are divided into

sections that are mutually exclusive (i.e. at least via the maps in the figures and

description of regions at col. 17 and col. 21; it could also be considered together or

separately as the coverage areas as described in col. 15; this may similarly be

described by data alone as in the case with regions by zip code at col. 20 and 23,

geocode, passim, etc.);

receiving a query for defining a geographic area wherein the query includes an

indication of at least one of a set of subregions and a set of sections (i.e. via at least col.

15 line 64 through col. 16 line or geocode searches specific to the "regions", passim);

determining whether the reference to at least one of the set of subregions and

the set of sections indicates the at least one of the set of subregions and the set of

sections are to be included in the geographic area (i.e. at a minimum, inherent via the

search or query feature to determine the region being searched for as described,

passim);

determining whether the reference to the at least one of the set of subregions

and the set of sections indicates the at least one of the set of subregions and the set of

sections are to be excluded from the geographic area (i.e. at a minimum, inherently via

a query or search in the case that the search or query fails to find a match, passim.);

and outputting a response including information relating to the geographic area

wherein the geographic area is representative of the query (i.e. via the map generation

of the search query results, col. 15 and col. 16).

13.   **With respect to claims 2, 15, 28 and 41:**

Cossins et al. teaches the method of claims 1, 14, 27 and 40 respectively,

wherein the subregions are states and the sections are postal codes (i.e. via at least at

col. 20 lines 1-36, passim for the proposition that there are various descriptions of

searching by state or postal code which represent query collections).

14.   **With respect to claims 3, 16, 29, 42:**

Cossins et al. teaches the method of claims 2, 15, 28 and 41 respectively,

wherein sections can be identified by at least one number included in the postal code,

starting with the first number of the postal code (i.e. via at least a similar rejection as

that of claims 2, 15, 28 and 41 wherein the postal code has at least one number

associated with one number).

15.   **With respect to claims 5, 18, 31 and 44:**

Cossins et al. teaches the method of claims 1, 14, 27 and 40 respectively,

wherein outputting the response further includes:

incorporating in the response a pictorial diagram of the geographic area (i.e. via

the map generation, Figures, passim);

and depicting the subregions and sections that are included in the geographic

region in a different manner than the subregions and sections that are excluded from

geographic area (i.e. via the several interpretations such as coverage area regions at

col. 15, lines 17-27; Figures 37-39 with descriptions; and/or col. 10 lines 57- col. 11, line

4, passim, for the proposition that color representation is discussed throughout).

16.   **With respect to claims 6, 19, 32 and 45:**

Cossins et al. teaches the method of claims 5, 18, 31 and 44 respectively,

wherein depicting the subregions and sections further includes denoting the subregions

and sections included in the geographic area in a different color than the subregions

and sections that are excluded from the geographic area (i.e. via the several

interpretations such as coverage area regions at col. 15, lines 17-27; Figures 37-39 with

descriptions for different shades of grey; and/or col. 10 lines 57- col. 11, line 4, passim,

for the proposition that color representation is discussed throughout).

17.   **With respect to claims 7, 20, 33 and 46:**

Cossins et al. teaches the method of claims 5, 18, 31 and 44 respectively,

wherein depicting the subregions and sections further includes denoting the subregions

and sections included in the geographic area in a different shading than the subregions

and sections that are excluded from the geographic area(i.e. via the several

interpretations such as coverage area regions at col. 15, lines 17-27; Figures 37-39 with

descriptions denoting different shades of grey; and/or col. 10 lines 57- col. 11, line 4,

passim, for the proposition that color representation is discussed throughout).

Claim Rejections - 35 USC § 103

18.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

19.   **Claims 4, 8-13, 17, 21-26, 30, 34-39, 43, and 47-52 are rejected under 35**

U.S.C. 103(a) as being unpatentable over Cossins et al. in view of Metacrawler

Query Submission (05/18/1997; hereinafter "Meta") and/or the Quick Reference

Guide to Search Engine Syntax (04/07/2001; hereinafter "Guide").

20.   **With respect to claims 4, 17, 30 and 43:**

Cossins et al. teaches the method of claims 1, 14, 27 and 40 respectively, and

the use of search query to identify regions in a geographic area, except for explicitly

reciting the receiving a query includes:

incorporating in the query a plus sign to add at least one of a subregion

contained in the set of subregions and a section contained in the set of sections to the

geographic area;

and incorporating in the query a minus sign to exclude at least one of a

subregion contained in the set of subregions and a section contained in the set of

sections to the geographic area.

However, Meta and Guide both teach search engine or search query syntax

where common search syntax terms such as "and" or "not" are used interchangeably

with a "plus sign" or a "minus sign" and are common to search term syntax when

attempting to search for terms and exclude terms from a search. For example Meta

teaches "THE PLUS SIGN: + A plus sign to designates a word that must be present in

the document…" and "THE MINUS SIGN: - A minus sign designates a word that must

not be present in the document." This is similarly taught and excepted in the Guide

prior art as well.

Therefore, it would have been obvious to one of ordinary skill in the art, at the

time of invention to have modified the search query system of Cossins et al. with the

search engine syntax query method of utilizing the plus or minus query syntax as taught

by Meta and/or Guide in order to include or exclude search items from the search query

for the well known purpose of allowing greater syntax options for broadening or

narrowing a search query to more appropriately determine or identify search results

requested. In short, it is clearly old and well known to provide specific syntax of the plus

and minus sign to search through a query search.

21.   **With respect to claims 8, 21, 34 and 47:**

Cossins et al. teaches a method for defining and identifying geographic areas,

comprising:

providing for a geographic region wherein the geographic region is divided into states, and wherein the states are divided into postal codes; receiving a query to identify a geographic area wherein the query includes an indication of at least one of a set of states and a set of postal codes and outputting a response including information related to the geographic area (i.e. limitations similarly rejected under that of claims 1, 14, 27 and 40 for the proposition that the query may be by state and/or postal code where the results of the query is outputted to a map for display).

However, it appears that Cossins et al. fails to explicitly recite including in the query at least one of a plus sign and a minus sign, wherein the plus sign is included when at least one of the set of states and one of the set of postal codes is to be included in the geographic area and a minus sign is included when at least one of the set of states or one of the set of postal codes is to be excluded from the geographic region wherein the at least one of the set of states and the set of postal codes preceded with a plus sign is included in the geographic area and the at least one of the set of states and the set of postal codes preceded with a minus sign is excluded from the geographic area.

However, Meta and Guide both teach search engine or search query syntax where common search syntax terms such as "and" or "not" are used interchangeably with a "plus sign" or a "minus sign" and are common to search term syntax when attempting to search for terms and exclude terms from a search. For example Meta teaches "THE PLUS SIGN: + A plus sign to designates a word that must be present in

the document..." and "THE MINUS SIGN: - A minus sign designates a word that must

not be present in the document." This is similarly taught and excepted in the Guide

prior art as well.

Therefore, it would have been obvious to one of ordinary skill in the art, at the

time of invention to have modified the search query system of Cossins et al. with the

search engine syntax query method of utilizing the plus or minus query syntax as taught

by Meta and/or Guide in order to include or exclude search items from the search query

for the well known purpose of allowing greater syntax options for broadening or

narrowing a search query to more appropriately determine or identify search results

requested. In short, it is clearly old and well known to provide specific syntax of the plus

and minus sign to search through a query search.

22.   **With respect to claims 9, 22, 35 and 48:**

The combination of Cossins et al. and Meta or Guide both teach the method of

claims 8, 21, 34 and 47 respectively, wherein postal codes can be identified by at least

one number included in the postal code, starting with the first number of the postal code

(i.e. via at least Cossins et al., at col. 20 lines 1-36, passim for the proposition that there

are various descriptions of searching by state or postal code which represent query

collections, wherein the postal code has at least one number associated with one

number).

23.   **With respect to claims 10, 23, 36 and 49:**

The combination of Cossins et al. and Meta or Guide both teach the method of

claims 8, 22, 34 and 47 respectively, wherein the response includes a pictorial diagram

wherein the identified geographic area is viewably different than those states and postal codes that are excluded from the geographic area (i.e. via Cossins et al., to include several interpretations such as coverage area regions at col. 15, lines 17-27; Figures 37-39 with descriptions for different shades of grey; and/or col. 10 lines 57- col. 11, line 4, passim, for the proposition that color representation is discussed throughout).

24. **With respect to claims 11, 24, 37 and 50:**

Cossins et al. teaches a method for defining and identifying a geographic area, comprising:

providing for a geographic region wherein the geographic region is divided into subregions that are mutually exclusive, and wherein the subregions are divided sections that are mutually exclusive (i.e. via the process of search query allowing for search by state, zip code, etc. as similarly rejected);

receiving a query to define a geographic area wherein the query includes an indication of at least one of a set of subregions and a set of sections and outputting a pictorial diagram representative of the query wherein the pictorial diagram includes at least part of the region including the defined geographic area wherein the geographic area is viewably different from the subregions and sections that are excluded from the geographic area (i.e. via limitations similarly rejected under that of claims 1, 14, 27 and 40 for the proposition that the query may be by state and/or postal code as subregions and sections where the results of the query is outputted to a map for display).

However, it appears that Cossins et al. fails to explicitly recite including in the query at least one of a plus sign and a minus sign, wherein the plus sign is included

when at least one of the set of subregions and one of the set of sections is to be included in the geographic area and a minus sign is included when at least one of the set of subregions or one of the set of sections is to be excluded from the geographic region.

However, Meta and Guide both teach search engine or search query syntax where common search syntax terms such as "and" or "not" are used interchangeably with a "plus sign" or a "minus sign" and are common to search term syntax when attempting to search for terms and exclude terms from a search. For example Meta teaches "THE PLUS SIGN: + A plus sign to designates a word that must be present in the document..." and "THE MINUS SIGN: - A minus sign designates a word that must not be present in the document." This is similarly taught and excepted in the Guide prior art as well.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of invention to have modified the search query system of Cossins et al. with the search engine syntax query method of utilizing the plus or minus query syntax as taught by Meta and/or Guide in order to include or exclude search items from the search query for the well known purpose of allowing greater syntax options for broadening or narrowing a search query to more appropriately determine or identify search results requested. In short, it is clearly old and well known to provide specific syntax of the plus and minus sign to search through a query search.

25.   **With respect to claims 12, 25, 38 and 51:**

The method of claims 11, 24, 37 and 50 respectively, wherein the subregions are

states and the sections are postal codes (i.e. via Cossins et al., at least at col. 20 lines

1-36, passim for the proposition that there are various descriptions of searching by state

or postal code which represent query collections).

26.   **With respect to claims 13, 26, 39, 52:**

The method of claims 12, 24, 38 and 51 respectively, wherein sections can be

identified by at least one number included in the postal code, starting with the first

number of the postal (i.e. via at least Cossins et al., at col. 20 lines 1-36, passim for the

proposition that there are various descriptions of searching by state or postal code

which represent query collections, wherein the postal code has at least one number

associated with one number).

Conclusion

27.   The Examiner has pointed out particular references contained in the prior art of

record, within the body of this action for the convenience of the Applicant. Although the

specified citations are representative of the teachings in the art and are applied to the

specific limitations within the individual claim, other passages and figures may apply.

Applicant, in preparing the response, should consider fully the entire reference as

potentially teaching all or part of the claimed invention, as well as the context of the

passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Michael M. Thompson whose telephone number is (571)

270-3605. The examiner can normally be reached on Monday thru Friday 8am-5:30

except Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

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USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael M Thompson/
Examiner, Art Unit 3629

/JOHN G. WEISS/
Supervisory Patent Examiner, Art Unit 3629